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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Yvonne F. Bell

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The John Marshall Law School
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315 S. Plymouth Court
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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT

PAPER NUMBER

3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/774,807	Applicant(s) BELL, YVONNE F.	
	Examiner LUKE GILLIGAN	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In the amendment filed 11/25/09, the following has occurred: claim 5 has been amended. Now, claims 1-5 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 5 recites the limitation "including any insurance companies and the Social Security Administration." Due to the use of the term "any," it is unclear whether the entities following this term are required to be included or are optionally included if applicable. For the purpose of applying art, the examiner will interpret this limitation as optionally including the entities if applicable.

5. Claim 5 also recites the limitation "acting on said data to provide any compensation due to beneficiaries of the patient covered by the death notice." As above, the use of the term "any" renders the limitation indefinite. It is unclear whether the claim requires compensation to be provided to the beneficiaries of the patient or optionally provides compensation to the beneficiaries of the patient if applicable. For the purpose of applying art, the examiner will interpret this limitation as optionally providing compensation to the beneficiaries of the patient if applicable.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Claim 5 is rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilsky, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); and Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

9. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied. This can be done, for example, by identifying the apparatus that accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

10. Applicant's method steps in claim 5 fail the new Federal Circuit decision since they are not tied to a particular machine and fail to transform underlying subject matter

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to a different state or thing. For example the steps of "providing," "retaining," and "acting" could all be carried out manually without the use of a particular machine such as a computer or processor and the steps do not involve the transformation of underlying subject matter to a different state or thing. Although, the "transmitting" step occurs "via a computer network," this is a mere data transmission step and, therefore, directed to insignificant extra-solution activity.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arbuckle, U.S. Patent No. 5,651,117 in view of PR Newswire, New York State Relies on Sybase to Simplify and Streamline Processing of Death Certificates (hereinafter EDRS, paragraphs numbered by Examiner) and further in view of Green, US Patent Applicant Publication No. 2003/0009418 and Joao, US Patent No. 7,305,347.

13. As per claim 1, Arbuckle teaches a computer network system used to inform concerned entities that a person has died comprising: various sources which transmit a death notice to a funeral home informing the funeral home of the death of a patient (see column 6, lines 16-22); a funeral home to receive the death notice from the sources, said funeral home being linked by a computer network to concerned entities (see

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column 8, lines 45-48, note that in some embodiments, the depository is also the funeral home, see column 3, lines 29-35); said concerned entities being linked to said computer network of the funeral home to receive the death notice (see column 8, line 64 – column 9, line 7).

14. Although Arbuckle teaches that death notices can be received from special sources that include any domain agreed upon to be monitored (see column 6, lines 41-44), the references does not explicitly teach that the special sources include a patient care facility. However, EDRS discloses electronic submission of death notices by a patient care facility (see paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to include this domain to be monitored into the system of Arbuckle. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the ability to assure timely notice of a given death by broadening the domains to be monitored (see column 1, lines 52-55 of Arbuckle).

15. Although Arbuckle is directed to informing any contracting customer of a given death, the reference does not explicitly identify an insurance company nor the Social Security Administration as a contracting customer. However, Green teaches a computer network that links concerned entities including the Social Security Administration (see abstract and paragraph 0024). Joao teaches a computer network that links concerned entities including an insurance company (Figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to understand that any type of concerned entity can contract with the depository of Arbuckle. Adding

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the Social Security Administration and insurance company to the computer network of Arbuckle would not have required modification to the existing systems of Arbuckle, Green, or Joao and the results of the combination would have been predictable.

16. As per claim 2, Arbuckle in view of EDRS, Green and Joao teach the system of claim 1 as described above. Arbuckle further teaches said concerned entities linked to the computer network and the funeral home also include a government entity charged with maintaining vital statistics within a community including deaths (see column 6, lines 25-34).

17. As per claim 3, Arbuckle in view of EDRS, Green and Joao teach the system of claim 2 as described above. Arbuckle further teaches said monitored sources are linked to said funeral home by a digital transmitting medium and hardware capable of transmitting a digital signal from the sources which can be received by the funeral home (see Figure 1)

18. As per claim 4, Arbuckle in view of EDRS, Green and Joao teach the system of claim 3 as described above. Arbuckle does not explicitly teach including a pension plan administration office linked to said funeral home through the computer network to receive and transmit digital signals. Joao further teaches a pension plan administration office linked to said centralized system through the computer network to receive and transmit digital signals (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to understand that any type of concerned entity can contract with the depository of Arbuckle for the reasons given above with respect to claim 1.

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19. Claim 5 recites substantially similar method limitations to system claim 1 and, as such, is rejected for similar reasons as given above..

Response to Arguments

20. In the remarks filed 11/25/09, Applicant argues that the EDRS references makes no mention of patient care facilities. In response to Applicant's argument, It is respectfully noted that the EDRS reference describes "hospital workers" as being linked to the central computer system. Given the broadest reasonable interpretation to one of ordinary skill in the art, a collection of hospital workers (presumably at a hospital) represents a patient care facility. Therefore, this argument is not found to be persuasive.

21. Applicant's also argue that there is no teaching of providing compensation due to beneficiaries of the patient. However, as noted above in the rejections under 112, second paragraph, this limitation is optional due to the use of the term any.

22. Applicant's remaining arguments are moot in view of the new grounds of rejection.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE GILLIGAN whose telephone number is (571)272-6770. The examiner can normally be reached on Monday-Thursday and every other Friday.

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24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on 571-272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. Luke Gilligan/
Primary Examiner, Art Unit 3626